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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,852	09/19/2001	Helge Ahrens	Bciersdorf 742-KGB	9878
7590 06/04/2004			EXAMINER	
Kurt G. Briscoe Norris McLaughlin & Marcus, P.A. 220 East 42nd Street - 30th Floor New York, NY 10017			GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,852

Applicant(s)

AHRENS ET AL.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The receipt is acknowledged of applicants' amendment and request under 1.114, both filed 04/30/2004.

Claim 1 has been cancelled.

Claims 2, 4-12 are included in the prosecution.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/30/2004 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2, 4-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9-13 of copending Application No. 09/951,089. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of the copending applications claims common subject matter of a dressing comprising carrier film, an adhesive layer and beveled polyurethane matrix centrally disposed on the adhesive layer. The difference between the instant claims and the copending claims is the material of the carrier layer. This is anticipatory double patenting rejection because the instantly claimed dressing is anticipated by the dressing claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague as they do not recite the position of the adhesive-rejecting carrier material in relation to the other layers.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2, 4, 7, 10, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,377,159 ('159).

US '159 disclosed a pressure bandage for the wounds comprising a carrier tape uniformly covered by a pressure sensitive adhesive layer adheres to it a prism-shaped section that is beveled as shown from figure 1 (abstract; figure 1; col.1, lines 36-39; col.2, lines 55-59; col.4, lines 34-37). The adhesive layer extends beyond the prism shaped section to adhere to the skin (figure 7; col.4, lines 29-33). The prism-shaped section is polyurethane foam and the pressure sensitive adhesive is acrylic acid polymer and esters (col.4, lines 55-68; col.5, lines 23-25). The polyurethane foam may include active agent (col.5, lines 28-32).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '159 in view of US 4,867,748 ('748).

The teachings of US '159 are discussed under 102 rejection above.

However, US '159 does not teach the material of the carrier film as claimed on claim 5 or the cover of siliconized paper as claimed in claims 9 and 12.

US '748 teaches a wound dressing comprising central sealing pad that is beveled along all its outer edge in thickness dimension (col.2, lines 29-33). The sealing pad

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comprises polyurethane (col.3, line 64). The sealing pad is covered on one side by film made of polyurethane, polyethylene, polyester or polyamide, and on the other side by protective cover of siliconized paper (col.3, lines 34-46). These covering layers are water-tight and water insoluble and have high mechanical strength, and the siliconized paper film is easily detachable.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the wound dressing comprising carrier layer, an adhesive layer, and a beveled polyurethane section as disclosed by US '159, and select the materials for the carrier layer and the cover layer disclosed by US '748, motivated by the teaching of US '748 that the covering layers are water-tight and water insoluble and have high mechanical strength, and the siliconized paper film is easily detachable, with reasonable expectation of having a dressing with beveled polyurethane section carried on a layer of polyurethane, polyethylene, polyester or polyamide and covered by siliconized paper that is protected from the environmental effects and easily used.

11. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '159.

The teachings of the reference are discussed above.

However, the reference does not teach the claimed thickness of the carrier film and the adhesive layer.

The claimed thickness of the layers does not impart patentability to the claims because the art recognized dressing having the claimed structure, absent evidence to the contrary.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the wound dressing comprising carrier layer, an adhesive layer, and a beveled polyurethane section as disclosed by US '159, and adjust the thickness of different layers according to specific intended use, with reasonable expectation of having dressing with the claimed thickness of each layer.

Response to Arguments

12. Applicant's arguments with respect to claims 2, 4-12 have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

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ISIS GHALI
PATENT EXAMINER